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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/071,664 05/01/98 SHAFFER

S 98P7512US

EXAMINER

WM02/1113

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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BUT, R

ART UNIT

PAPER NUMBER

2642

DATE MAILED:

11/13/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/071,664

Applicant(s)

Shaffer et al

Examiner

Bing Bul

Group Art Unit

2642



☒ Responsive to communication(s) filed on Sep 18, 2000

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Claim Rejections - 35 U.S.C. § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1-7 and 9-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Rogers et al (US Pat No. 5,946,386).

Regarding claim 1, respect to fig 1, Rogers et al teach a method for providing an automated call connection system comprising the steps of:

initiating a call back request from a first user to a second user (col 15, ln 35-42 and col 37, ln 8-18);

sending the call back request from the first user to the second user (col 15, ln 35-42 and col 37, ln 8-18);

receiving the call back request (col 15, ln 35-42 and col 37, ln 8-18);

the second user choosing between acceptance and rejection of the call back request (col 15, ln 35-42 and col 37, ln 8-18); and

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if the second user chooses to accept the call back request, immediately and automatically attempting to connect the first user and the second user (col 15, ln 35-42 and col 37, ln 8-18).

Regarding claim 2, Rogers et al teach a method for providing an automated call connection system further comprising the step of using a separate packet-based network to determine if the second user is ready to accept the call back request (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Regarding claim 3, Rogers et al teach a method for providing an automated call connection system further comprising the step of bypassing call toll charges by using a packet-based network for the sending of call back requests (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Regarding claim 4, Rogers et al teach a method for providing an automated call connection system further comprising the step of utilizing a computer for the sending of the call back requests to a server collecting the call back requests for immediate delivery to the second user (col 11, ln 6-12 and col 15, ln 36-42).

Regarding claim 5, Rogers et al teach a method for providing an automated call connection system further comprising the call back requests are automatically sent via at least one of an E-mail message, a page and a facsimile (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Claims 6, 11 and 17 are rejected for the same reasons as recited in the rejection of claim 1.

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Claims 7, 9, 15-16 and 18 are rejected for the same reasons as recited in the rejection of claim 5.

Regarding claim 10, Rogers et al teach a method for providing an automated call connection system further comprising a personal digital assistant is used to initiate the call back request (Figs 1 and 6a-9ab; col 3, ln 56-65; col 4, ln 36-41 and col 11, ln 45-47).

Claim 12 is rejected for the same reasons as recited in the rejection of claim 2.

Claim 13 is rejected for the same reasons as recited in the rejection of claim 3.

Claim 14 is rejected for the same reasons as recited in the rejection of claim 4

3. Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Hsu (US Pat No. 5,661,790).

Regarding claims 1 and 11, respect to fig 2, Hsu teaches a method for providing an automated call connection system comprising the steps of:

initiating a call back request from a first user to a second user (Fig 2 and col 3, ln 58-col 4, ln 4);

sending the call back request from the first user to the second user (Fig 2 and col 3, ln 58-col 4, ln 4);

receiving the call back request (Fig 2 and col 3, ln 58-col 4, ln 4);

the second user choosing between acceptance and rejection of the call back request (Fig 2 and col 3, ln 58-col 4, ln 4); and

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if the second user chooses to accept the call back request, immediately and automatically attempting to connect the first user and the second user (Fig 2 and col 3, ln 58-col 4, ln 4).

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al as applied in claims 1 and 11 above, and further in view of Silverman (US Pat No. 6,035,031).

Regarding claims 8 and 19, Rogers et al teach the invention substantially as claimed, with the exception of providing the method of:

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maintaining a connection between the first user and the second user for a predetermined period of time;

wherein the predetermined period of time is specified by the first user.

However, Silverman discloses the invention substantially as claimed, the method of: maintaining a connection between the first user and the second user for a predetermined period of time (col 3, ln 31-41);

wherein the predetermined period of time is specified by the first user (col 3, ln 31-41).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the system and method for maintaining a connection between the first user and the second user for a predetermined period of time specified by the first user as taught by Hsu into view of Rogers et al such that requesting party for calling back can manage his time effectively.

6. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-6306, for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE")

or:

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(703) 308-6296, for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-6306 or (703) 308-6296.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2642.

Bing Bui

Patent Examiner

Nov 4, 2000


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600